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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/729,284 | 12/04/2003 | Donald E. Beeler JR. | 7192-202CON | 1578 |

7590 05/15/2006
Clifford Chance US LLP
200 Park Avenue
New York, NY 10166-0153

EXAMINER

RADTKE, MARK A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2165

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/729,284 | Applicant(s) BEELER, DONALD E. | |
| | Examiner Mark A. Radtke | Art Unit 2165 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:
 - a. In claim 1, line 6, the claim recites a "server for executing". The term "for" renders everything that follows in that limitation as "intended use". Examiner recommends making a correction to positively recite the entire limitation. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2 of the instant application are provisionally rejected under the judicially created doctrine of double patenting over claims 1-2 of U.S. Patent Number 5,974,563 (Beeler).

Claims 1-2 of the instant application are considered obvious over claims 1-2 of Patent 5,974,563. Claim 1 of the instant application and claim 1 of Beeler are identical, with the exception of an intended use phrase ("for executing a file modification request for a file modification"). Claim 2 of the instant application and claim 2 of Beeler are obvious variants of one another. The only difference is an additional two steps of "executing", specifically the first limitation (lines 17-19) and the fourth limitation (lines 27-29). However, the two omitted steps are implicitly carried out in the instant claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re

Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-2 are rejected under 35 U.S.C. 101 because the intended use as stated in the preamble of the claim must be carried out as the system or method is used. Neither claim explicitly performs a “real time backup”. Furthermore, the claims produce no tangible result. “Communicating” is not a tangible result. Two examples of tangible results are storing or displaying data.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert et al. (U.S. Patent 5,530,848).

As to claim 1, Gilbert et al. teaches a real time backup system (See Abstract, where “backup” is read on “transaction processing system”. A backup is a copy of data stored on a different computer or medium. Therefore, any data sent over a network to a database is a backup of that data which was previously stored on the local computer.) comprising:

at least one primary server having a non-volatile storage media where a file modification request for a file modification is saved (see Abstract, lines 12-15, where “primary server” is read on “external application”);

at least one secondary server for executing said file modification request, each secondary server having a non-volatile storage media where said file modification is saved (see Abstract, where “secondary server” is read on “transaction processing system” and see column 14, lines 61-63); and

a communication means for communicating said file modification request from said at least one primary server to said at least one secondary server (see Abstract, lines 12-15 and see figure 3, elements 300 and 302 and see column 11, line 62 – column 12, line 11).

As to claim 2, Gilbert et al. teaches a method for real time backup (see Abstract) comprising the steps of:

saving a file modification request for a file modification on at least one non-volatile storage media associated with at least one primary server (see figure 4, step 404 and see Abstract, lines 12-15);

executing said file modification request on at least one secondary server, each secondary server having a non-volatile storage media (see Abstract, where “secondary server” is read on “transaction processing system” and see column 14, lines 61-63);

saving said file modification on said non-volatile storage media associated with said at least one secondary server (see figure 4, step 410 and see Abstract and see column 14, lines 61-63); and

communicating said file modification request from said at least one primary server to said at least one secondary server (see Abstract, lines 12-15 and see figure 3, elements 300 and 302 and see column 11, line 62 – column 12, line 11).

Conclusion

8. Any inquiry concerning this communication or earlier communications should be directed to the examiner, Mark A. Radtke. The examiner's telephone number is (571) 272-7163, and the examiner can normally be reached between 9 AM and 5 PM, Monday through Friday.

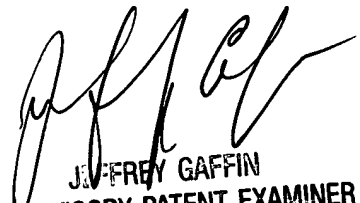
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If attempts to contact the examiner are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (800) 786-9199.

maxr

11 May 2006



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100